The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TARA BURNHOUSE, YUKO NISHIKAWA,
and DAYAN GOLDEN

Appeal 2007-0345
Application 09/812,417
Technology Center 2100

Decided: May 2, 2007

Before JOSEPH L. DIXON, ALLEN R. MACDONALD, and JOHN A. JEFFERY, *Administrative Patent Judges*.

JEFFERY, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-28. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE CASE

Appellants invented a method of indicating actions to be taken for selected programs listed in an electronic programming guide in, for example, a direct broadcast satellite system. Specifically, the system allows the user to select a specific future action (e.g., recording a program) and indicate the selected actions on a display. Claims 1 and 23 are illustrative:

1. A method for indicating future program action on a future program information display comprising:

providing future program information for a plurality of future programs, at least one future program being selected by a user;

providing, on a future program action menu, a plurality of future program actions for the selected future program, at least one future program action being selected by the user, each future program action being an action selected to be performed on a future program;

allowing the user to accept or modify the action;

receiving the selected at least one future program and the selected at least one future program action from the user; and

displaying the future program information of the selected at least one future program with an indicator such that the indicator indicates the selected at least one future program action.

23. A display for indicating future program action comprising:

a first image to provide future program information for a plurality of future programs, at least one future program selected by the user;

a second image comprising a future program actions menu including a plurality of future program actions for the selected at least one future program, each future program action being an action selected to be performed on one of the plurality of future programs;

a third image comprising information on the selected action to allow the user to accept or modify the action; and

at least one fourth image comprising the future program information having a future program action indicated.

The Examiner relies on the following prior art reference[1] to show unpatentability:

Lawler	US 5,585,838	Dec. 17, 1996

The Examiner's rejection is as follows:

Claims 1-28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lawler.

Rather than repeat the arguments of Appellants or the Examiner, we refer to the Brief and the Answer for their respective details. In this decision, we have considered only those arguments actually made by Appellants. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004).

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[1] The Examiner and Appellants refer to an incorrect patent number, U.S. Pat. 5,822,123, as corresponding to the Lawler reference. *See* Answer 3 ("Evidence Relied Upon" section and reference to "Lawler '123" in Grounds of Rejection); *see also* Br. 5, 7. U.S. Pat. 5,822,123 actually refers to the Davis reference cited in the Examiner's non-final rejection mailed Sept. 25, 2003. *See* Non-final Rejection mailed Sept. 25, 2003, at 2; *see also* PTO-892 dated Sept. 25, 2003. The Examiner, however, also cites the correct patent number of the Lawler reference in line 3 of the Grounds of Rejection section.

Since the arguments and discussion in the Answer and the Brief are directed to the Lawler reference (US 5,585,838), we presume that the rejection was based solely on Lawler. Accordingly, our decision is based solely on the disclosure of Lawler; the Davis reference is therefore not before us.

OPINION

It is our view, after consideration of the record before us, that the disclosure of Lawler fully meets the invention set forth in the claims on appeal. We also enter new grounds of rejection under 37 C.F.R. § 41.50(b) for claims 1-4, 6-8, and 23-28 as failing to recite statutory subject matter under 35 U.S.C. § 101.

The Anticipation Rejection

We first consider the Examiner's rejection of claims 1-28 under 35 U.S.C. § 102(b) as being anticipated by Lawler. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); *W.L. Gore and Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983).

The Examiner has indicated how the claimed invention is deemed to be fully met by the disclosure of Lawler (Answer 3-5). Regarding independent claims 1, 9, 17, and 23, Appellants argue, among other things, that Lawler's various program option buttons merely cause the option to be performed; the user, however, is not given the opportunity to accept or modify the action as claimed (Br. 6). Appellants also argue that Lawler does not disclose an indicator to indicate the selected future program action as claimed (*Id.*). The Examiner argues that Lawler's icon function indicates whether a future program action will occur (Answer 6-7).

We will sustain the Examiner's rejection of independent claims 1, 9, 17, and 23. In Fig. 8, Lawler shows a program time guide along with an exemplary future program options menu 136. Significantly, the future program options menu includes a set of buttons that, when activated, perform certain actions with respect to the selected future program. The buttons include: (1) an "Order" button 138 that allows the user to order the selected program; (2) a "Remind" button 140 that causes the system to set a reminder for the selected program; (3) a "Record" button 130 that causes the system to record the show when it becomes available in the future; and (4) a "Cancel" button 132 that returns the user to the program time guide without performing any action (Lawler, Fig. 8; col. 14, ll. 23-48).

In addition, user-specific icons may be provided to indicate certain characteristics set by the user such as whether the user set a reminder for the indicated program, or (2) whether the user requested recording of the indicated program (Lawler, col. 10, ll. 34-39).

We agree with the Examiner that Lawler's system enables the user to perform and indicate certain selected "future program actions" and therefore fully meets the independent claims. In our view, Lawler's icon function indicates a future program action, particularly since these "action-descriptive" icons (claims 2, 10, 18, and 24) indicate at least two functions that are activated by the buttons on the future program options menu: (1) setting a reminder, and (2) requesting recording. Not only does Lawler's system allow the user to accept the action (i.e., by activating the function corresponding to the selected button on the future program options menu), it also allows the user to modify the action as claimed by merely selecting the "Cancel" button.

For at least these reasons, Lawler fully meets all limitations of claims 1, 2, 9, 10, 17, 18, 23, and 24. Accordingly, the Examiner's anticipation rejection of those claims is sustained.

Regarding claims 3, 11, 19, and 25, we note at the outset that the claims call for the future programs menu to comprise features *selected from the group* consisting of (1) a return feature, and (2) a help feature (emphasis added). That is, only one recited feature – not necessarily both – need be disclosed in Lawler to anticipate the claims.

With this interpretation, we turn to Lawler. The reference specifically states that the CPU 58 monitors the user's menu selection, carries out the requested action, and *returns* to the program time guide (Lawler, col. 14, ll. 25-29; Fig. 5A; emphasis added). Although this functionality fully meets the claimed return feature given the scope and breadth of the limitation, we add that activating the "Cancel" button also returns the user to the program time guide – a feature that also fully meets the claimed return feature (Lawler, col. 14, ll. 45-48).

Furthermore, the information displayed in Figs. 3 and 8 fully meets the claimed help feature giving the term "help feature" its broadest reasonable interpretation. In our view, the limitation is fully met by the user's ability in Lawler to navigate among the various programs in the display screen that are categorized by time and channel, and retrieve additional information about the programs.

For at least these reasons, Lawler fully meets the limitations of claims 3, 11, 19, and 25. Accordingly, the Examiner's anticipation of those claims is sustained.

Claims 4 and 12 are also fully met by Lawler. Focus frame 102 in Fig. 8 "highlights" the selected future program by either drawing a conspicuous border around the program tile or shading it in a different color. *See* Lawler, col. 9, ll. 59-64; *see also* Fig. 8. For at least these reasons, we will sustain the Examiner's anticipation rejection of claims 4 and 12.

Regarding claims 5 and 13,[2] we find that the window in which the future program actions menu is displayed in Fig. 8 of Lawler reasonably constitutes a "popup window" giving the term its broadest reasonable interpretation. Significantly, the claims do not recite any further details regarding the displayed window apart from characterizing it as a "popup window." In short, Appellants' arguments are not commensurate with the scope of the claims. The rejection of claims 5 and 13 based on the disclosure of Lawler is therefore sustained.

We will also sustain the Examiner's rejection of claims 6, 7, 14, 15, 20, 21, 26, and 27. At the outset, we note that Appellants did not separately argue the limitations of claims 6, 14, 20, and 26 with particularity, but merely alleged that Lawler did not disclose the claimed limitations (Br. 7-8 (Item (5)). Merely pointing out what a claim recites, however, is not considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii) (2004).

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[2] We note in passing that no antecedent basis exists for "*the* monitor display screen" in claims 5 and 13 (emphasis added). Because this issue was not raised on appeal, it is not before us. In an *ex parte* appeal, "the Board is basically a board of review – we review...rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (B.P.A.I. 2001). Therefore, we leave the resolution of this issue to the Examiner and the Appellants.

In any event, we conclude that Lawler anticipates claims 6, 14, 20, and 26. Significantly, the claims merely call for the future program action to be *selected from the group* consisting of various future program actions, including recording the selected at least one future program – a feature disclosed by Lawler as we previously indicated.[3] Since Lawler discloses at least one of the future program actions in the group of future program actions recited in claims 6, 14, 20, and 26, Lawler anticipates those claims.

Regarding claims 7, 15,[4] 21, and 27, we note that Lawler teaches that activating the Record button causes the system to record the show when it becomes available in the future (col. 14, ll. 43-45). Even assuming, without deciding, that this teaching requires precisely the same start times for both the future program action (i.e., recording) and the future program, the scope and breadth of the claims simply does not preclude the teachings of Lawler.

Significantly, the claims recite that the start *and/or* stop times of the future program action not match the start *and/or* stop times of the future program (emphasis added). Due to the presence of the two "and/or" limitations, the claims recite several limitations in the alternative. These alternative limitations include at least one limitation that is inherent in Lawler's ability to record future programs noted above: the *start* time of the future program action does not match the *stop* time of the future program.

Because Lawler discloses at least one of the recited alternative limitations recited in claims 7, 15, 21, and 27, the Examiner's anticipation rejection of those claims will be sustained. Moreover, since Appellants have

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[3] *See* Page 5, *supra*, of this opinion.
[4] We note that a typographical error exists in line 1 of claim 15 ("claims 14" [sic]).

not separately argued the patentability of dependent claims 8, 16, 22, and 28 with particularity,[5] these claims fall with the independent claims. *See In re Nielson*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); *see also* 37 C.F.R. § 41.37(c)(1)(vii).

For at least the above reasons, the Examiner's anticipation rejection of claims 1-28 is sustained.

New Grounds of Rejection Under 37 C.F.R. § 41.50(b)

Under 37 C.F.R. § 41.50(b), we enter two new grounds of rejection under 35 U.S.C. § 101: (1) a new ground of rejection for claims 1-4 and 6-8, and (2) a new ground of rejection of claims 23-28. The basis for each is set forth in detail below.

35 U.S.C. § 101 provides:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Rejection of Claims 1-4 and 6-8 Under 35 U.S.C. § 101

Claims 1-4 and 6-8 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

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[5] Although Appellants nominally argue the limitations recited in these claims in Item (7) in the paragraph bridging Pages 7 and 8 of the Brief, Appellants merely reiterate the claim language without presenting specific arguments or supporting analysis pertaining to these limitations. Merely reciting the claim language, however, hardly suffices as a separate argument for patentability of the claims. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2004). Therefore, Appellants have not persuasively rebutted the Examiner's prima facie case of anticipation for these claims.

At the outset, we note that claims 1-4 and 6-8, given their broadest reasonable interpretation, do not require computer or machine implementation. The issue is whether these claims, which cover methods of indicating future program action on a future program information display involving no transformation and no process involving the other three statutory categories (machine, manufacture, or composition of matter),[6] recite patentable subject matter under 35 U.S.C. § 101. Giving the claim limitations their broadest reasonable interpretation, we conclude that claims 1-4 and 6-8 are unpatentable under section 101 because (i) they do not qualify as a "process" under section 101 as that term has been interpreted by case law, (ii) they seek to patent an abstract idea, and (iii) the "useful, concrete, and tangible result" test does not apply.[7]

Method claim 1 differs from traditional process claims in several respects. For example, the claim does not recite any particular machine or apparatus to perform the recited steps. In addition, the method claim does not recite any electrical, chemical, or mechanical acts or results, which are typical in traditional process claims. Finally, the claim does not call for any

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[6] "A machine is a concrete thing, consisting of parts, or of certain devices and combination of devices." *Burr v. Duryee*, 68 U.S. 531, 570 (1863). The term "manufacture" refers to "'the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery.'" *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 196-97 (1980) (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11, 8 USPQ 131, 133 (1931)). A "composition of matter" by its own terms requires matter. *Chakrabarty*, 447 U.S. at 308, 206 USPQ at 196-97.

[7] *See* Pages 21-24, *infra*, of this opinion.

physical transformation of an article to a different state or thing, nor does it require any transformation of data or signals.

The question of whether any of these distinctions takes claim 1 outside the realm of patent-eligible subject matter has never been squarely addressed by the Federal Circuit or the U.S. Supreme Court. Nevertheless, Appellants' claims are not the type of method that the Supreme Court or Federal Circuit has ever found patentable under section 101.

Reading the Supreme Court's and Federal Circuit's Precedents Together, A Section 101 "Process" Has Always Transformed Subject Matter, Whether Tangible or Intangible, or Has Been a Process That Involved the Other Three Statutory Categories

The scope of patentable subject matter under section 101 is broad, but not infinitely broad. "Congress included in patentable subject matter *only* those things that qualify as 'any ... process, machine, manufacture, or composition of matter, or any ... improvement thereof....'" *In re Warmerdam*, 33 F.3d 1354, 1358, 31 USPQ2d 1754, 1757 (Fed. Cir. 1994) (quoting 35 U.S.C. § 101) (emphasis added). Thus, "[d]espite the oft-quoted statement in the legislative history of the 1952 Patent Act that Congress intended that statutory subject matter 'include anything under the sun that is made by man,'[citation omitted], Congress did not so mandate." *Id.*

In the case where a claim is for a process, as opposed to a product, "[t]he line between a patentable 'process' and an unpatentable 'principle' is not always clear. Both are 'conception[s] of the mind, seen only by [their] effects when being executed or performed." *Parker v. Flook*, 437 U.S. 584, 589, 198 USPQ 193, 198 (1978) (quoting *Tilghman v. Proctor*, 102 U.S.

707, 728 (1880)). "The holding that the discovery of [*Benson*'s] method could not be patented as a 'process' forecloses a purely literal reading of § 101." *Flook*, 437 U.S. at 589, 198 USPQ at 197. "[W]hen a claim containing [an abstract idea] implements or applies that [idea] in a structure or process which, when considered as a whole, is performing a function which the patent laws were designed to protect (*e.g.*, transforming or reducing an article to a different state or thing), then the claim satisfies the requirements of § 101." *Diamond v. Diehr*, 450 U.S. 175, 192, 209 USPQ 1, 10 (1981); *see also Gottschalk v. Benson*, 409 U.S. 64, 70, 175 USPQ 673, 676 (1972) ("Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines.").[8]

The Supreme Court, however, presumably concerned about barring patents for future, unforeseeable technologies, declined to rule on whether its precedent foreclosed any other possible avenues for a method claim to qualify as a section 101 process: "It is argued that a process patent must either be tied to a particular machine or apparatus or must operate to change articles or materials to a 'different state or thing.' We do not hold that no process patent could ever qualify if it did not meet the requirements of our

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[8] The principal exception to this rule, as explained *infra*, is when the machine-implemented method merely manipulates abstractions. *See Benson*, 409 U.S. at 71-72, 175 USPQ at 676-677. In addition, merely attaching a machine to an otherwise ineligible method may not be sufficient and would depend on how the machine actually implemented the recited steps. For example, if a nonstatutory claim were amended so that a recited step of registering a customer was performed by entering data into a computer rather than using a sign-up sheet, it is hard to imagine how that alone would satisfy the requirements of § 101 and convert an otherwise ineligible claim into an eligible one.

prior precedents." *Benson*, 409 U.S. at 71, 175 USPQ at 676-677. Rather than rule on this question in *Benson* and *Flook*, the Supreme Court decided those cases based on the abstract idea exception to patentability. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-677; *Flook*, 437 U.S. at 594-95, 198 USPQ at 199-200.

Since *Diehr*, the Federal Circuit has reviewed several computer technology cases, and in acknowledgment of the innovations occurring in this technological field, identified a third category of method claims that qualify as a "process." Extrapolating from the Supreme Court's "transformation and reduction of an article" test, the Federal Circuit has held that transformation of intangible subject matter (*i.e.*, data or signals) may also qualify as a § 101 process. *See, e.g., State St. Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998). Responding to the argument that process claims must recite a "physical transformation," the Federal Circuit in *AT&T* ruled that "physical transformation" "is not an invariable requirement, but merely one example of how a mathematical algorithm may bring about a useful application." *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). Quoting the Supreme Court's language, "*e.g.*, transforming or reducing an article to a different state or thing" from *Diehr*, the *AT&T* court noted the usage of "*e.g.*" "denotes an example, not an exclusive requirement." *Id.* at 1359, 50 USPQ2d at 1452. *AT&T* went on to cite the transformation of intangible data signals in the method claim of *Arrhythmia Research Technology Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1059, 22 USPQ2d 1033, 1038 (Fed. Cir.

1992), as an example that qualifies as a § 101 "process" in addition to the Supreme Court's test. *See id.* at 1359, 50 USPQ2d at 1452.

Accordingly, the Federal Circuit has consistently used its own "data transformation" test in assessing the eligibility of various machine-implemented claims. In *Alappat*, the court held that "data, transformed by a machine" "to produce a smooth waveform display" "constituted a practical application of an abstract idea." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601. Specifically, the court in *Alappat* stated that the claimed invention as a whole was directed to a machine for "converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means." 33 F.3d 1526, 1544, 31 USPQ2d 1545, 1557 (Fed. Cir. 1994) (en banc). In *Arrhythmia*, the court held "the transformation of electrocardiograph signals" "by a machine" "constituted a practical application of an abstract idea." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601. Specifically, the court in *Arrhythmia* stated "the number obtained is not a mathematical abstraction; it is a measure in microvolts of a specified heart activity, an indicator of the risk of ventricular tachycardia." 958 F.2d at 1062, 22 USPQ2d at 1039. Likewise, in *State Street*, the court held that "the transformation of data" "by a machine" "into a final share price, constitutes a practical application of a mathematical algorithm" because "a final share price [is] momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades." 149 F.3d at 1373, 47 USPQ2d at 1601. Thus, while *Diehr* involved the transformation of a tangible object – curing synthetic rubber – the Federal Circuit also regards the transformation of intangible subject matter

to similarly be eligible, so long as data or signals represent some real world activity.

The Federal Circuit has never held or indicated that a process involving no transformation can qualify as a "process" under § 101. In fact, confronted with such claims, it has rejected them consistently. *See In re Schrader*, 22 F.3d 290, 294-295, 30 USPQ2d 1455, 1458 (Fed. Cir. 1994); *In re Grams*, 888 F.2d 835, 837, 12 USPQ2d 1824, 1826 (Fed. Cir. 1989) (rejecting claims to method of evaluating a system that incorporated a mathematical algorithm, where the only physical step was a data gathering step that was not tied to the algorithm); *In re Maucorps*, 609 F.2d 481, 484, 203 USPQ 812, 815 (CCPA 1979); *In re Meyer*, 688 F.2d 789, 796, 215 USPQ 193, 198 (CCPA 1982); *see also In re Alappat*, 33 F.3d at 1543, 31 USPQ2d at 1556 ("*Maucorps* dealt with a business methodology for deciding how salesmen should best handle respective customers and *Meyer* involved a 'system' for aiding a neurologist in diagnosing patients. Clearly, neither of the alleged 'inventions' in those cases falls within any § 101 category.").[9]

In *Schrader*, the court affirmed the 101 rejection of a method of competitively bidding on a plurality of related items, relying in part on the *Freeman-Walter-Abele* ("FWA") test. However, consistent with *Arrhythmia*, *Alappat*, *State Street*, and *AT&T*, the court also inquired into

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[9] *But see State Street*, 149 F.3d at 1376 n.14, 47 USPQ2d at 1603 n.14 (observing that "*Maucorp* and *Meyer* were subject to the *Benson* era *Freeman-Walter-Abele* test – in other words, analysis as it existed before *Diehr* and *Alappat*," without addressing the fact that it was the *Alappat* decision itself that made the observation that these inventions were "clearly" nonstatutory).

whether Schrader's method claim performed any kind of transformation. *Schrader*, 22 F.3d at 294, 30 USPQ2d at 1458 ("we do not find in the claim any kind of data transformation."). The court then distinguished Schrader's claim from the statutorily eligible claims in *Arrhythmia*, *In re Abele*, 684 F.2d 902, 905, 214 USPQ 682,685 (CCPA 1982), and *In re Taner*, 681 F.2d 787, 789-790, 214 USPQ 678, 680-681 (CCPA 1982), pointing out that in these cases, "[t]hese claims all involved the transformation or conversion of subject matter representative of or constituting *physical activity or objects*. *Id.* (emphasis in original). *Schrader* expressly concludes that "a process claim [in] compliance with Section 101 requires some kind of transformation or reduction of subject matter."[10] *Id.* at 295, 30 USPQ2d at

[10] Although the FWA test is no longer considered particularly probative in the context of computer-implemented process inventions in view of *Diehr* (*see, e.g.*, *State Street*, 149 F.3d at 1374, 47 USPQ2d at 1601), the erosion of FWA provides no support for the position that a non-machine implemented process, not involving any transformation, might be patentable. The answer to that question is still provided by *Schrader*, and that answer, so far, is negative. While *AT&T* indicated that *Schrader* is "unhelpful" because it did not reach the question whether a "useful, concrete, and tangible result" occurred, the reason that case did not need to reach that question was because it found that *Schrader's* method claims were unpatentable for lack of any transformation. In addition, *Schrader's* claims did not require machine-implementation, unlike AT&T's claims. *See AT&T*, 172 F.3d at 1358, 50 USPQ2d at 1452 ("AT&T's claimed process" uses "switching and recording mechanisms to create a signal useful for billing purposes."). Moreover, it is axiomatic that dicta in one Federal Circuit panel decision cannot overrule the holding of an earlier panel decision. *George E. Warren Corp. v. United States*, 341 F.3d 1348, 1351 (Fed. Cir. 2003) ("We cannot simply overrule [a prior panel] decision, even if we were persuaded . . . that it is appropriate; to overrule a precedent, the court must rule en banc" (citing *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 765, 9 USPQ2d 1417, 1423 (Fed.Cir.1988)).

1459. In sum, the Federal Circuit has never ruled that methods without any transformation are eligible, and appears in *Schrader* to have rejected that proposition.

We believe that "process" should not be broadened so as to include any method that may be deemed useful, such as Appellants' indication claims. The Supreme Court's and Federal Circuit's articulated eligibility tests keep the interpretation of "process" *in pari materia* with the other three categories of inventions – manufacture, machine, and composition of matter. In other words, interpreting "process" as either transforming subject matter or implemented by one of the other three categories of inventions is rationally consistent with and proportional to the types of inventions patented under the other categories.[11] *See Tilghman v. Proctor*, 102 U.S. 707, 722 (1880) ("where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes."); *see also AT&T*, 172 F.3d at 1356, 50 USPQ2d at 1450 ("any step-by-step process, be it electronic, chemical, or mechanical, involves an 'algorithm' in the broad sense of the term."). Accordingly, we do not believe that the boundaries of "process" should be so expansive as to accommodate all "useful" methods.

Following *Schrader*, Appellant's claims are unpatentable under section 101. The claims are similar to those rejected in *Schrader*, while

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[11] We do not propose in this decision a comprehensive rule for defining patentable subject matter in all circumstances. Rather, this decision illustrates that Appellants' claims fall outside the currently existing tests for eligibility and sees no reason to expand the existing tests to cover Appellants' claims.

distinguishable from *Arrhythmia*, *Alappat*, *State Street*, and *AT&T*. The claims do not transform any article to a different state or thing. The indication produced by the claims, while perhaps "useful" in one sense, is simply not the product of any transformation as understood in the case law. Further, the claims do not recite a process that employs the other statutory categories. Accordingly, the claims fail to meet any of the conditions set forth in the case law of either the Supreme Court or Federal Circuit.

Claims 1-4 and 6-8 Run Afoul of the "Abstract Idea" Exception

The Supreme Court has held that "[e]xcluded from such patent protection are laws of nature, natural phenomena, and abstract ideas." *Diehr*, 450 U.S. at 185, 209 USPQ at 7. "An idea of itself is not patentable.'" *Diehr*, 450 U.S. at 185, 209 USPQ at 7 (quoting *Rubber-Tip Pencil Co. v. Howard*, 20 Wall. 498, 507, 22 L.Ed. 410 (1874); *Benson*, 409 U.S. at 67, 175 USPQ at 675 ("[M]ental processes, and abstract intellectual concepts are not patentable."); *see also id.* at 71, 175 USPQ at 676 ("It is conceded that one may not patent an idea."). In contrast, "[i]t is now commonplace that an *application* of a law of nature or mathematical formula [or abstract idea] to a known structure or process may well be deserving of patent protection." *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis in original).

Clever claim drafting cannot circumvent these principles. That is, even when a claim appears to apply an idea or concept as part of a seemingly patentable process, one must ensure that it does not in reality seek patent protection for that idea in the abstract. *Diehr*, 450 U.S. at 191, 209 USPQ at 10. Similarly, one cannot patent a process that comprises "every substantial practical application" of an abstract idea, because such a patent "in practical

effect would be a patent on the [abstract idea] itself." *Benson*, 409 U.S. at 71-72, 175 USPQ 676-677.[12] Such limitations on process patents are important because without them, "a competent draftsman [could] evade the recognized limitations on the type of subject matter eligible for patent protection." *Diehr*, 450 U.S. at 192, 209 USPQ at 10.

Because Appellants' claim 1 is completely untethered from any sort of structure or physical step, it is directed to a disembodied concept. In other words, the claim is nothing but a disembodied abstract idea until it is instantiated in some physical way so as to be limited to a practical application of the idea.

For example, claim 1 does not recite any structural details regarding what constitutes a "future program information display." Also, the claim does not recite structural details regarding how the future program information of the selected future program is displayed, apart from broadly reciting an "indicator."

The term "display" is defined as "[a] visual representation of information."[13] Merely broadly reciting that a future program action is "indicated" on a "display" and "providing" a "future programs actions

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[12] The observation in *State Street* that "[w]hether the patent's claims are too broad to be patentable is not to be judged under § 101, but rather under §§ 102, 103, and 112" did not, nor could it, overrule the Supreme Court's pre-emption doctrine. *See State Street*, 149 F.3d at 1377, 47 USPQ2d at 1604. Rather, pre-emption was not at issue in *State Street* since the claim in that case was particularly confined to a machine implementation, and did not suffer from the same defect as Appellants' claim.

[13] The American Heritage Dictionary of the English Language, 4th ed., 2000, *available at* http:// www.bartleby.com/61/15/D0281500.html (last visited Mar. 22, 2007).

menu" -- without more -- merely describes the goals of the concept (i.e., visually representing the future program action).

Although the dissent states that the specification is *solely* directed to a computer-implemented invention,[14] we find the specification to not be so limiting. Indeed, the specification makes clear that the disclosed future program action indication display is merely an exemplary embodiment and illustrative—not the sole implementation as the dissent suggests. *See* Specification ¶ 0045.[15] In our view, such a broad, sweeping statement in the specification hardly limits the invention to a machine implementation, let alone a computer implementation.

The dissent concludes that the steps recited in claim 1 constitute a statutory process where data is transformed by a machine, specifically interacting with a computer-implemented process and display.[16] But the dissent's argument is effectively premised on a single preferred embodiment described in the specification.

To support the conclusion that the recited method steps of claim 1 are "computer implemented" -- a term that appears nowhere in the claim[17] -- the

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[14] *See* Dissent, at 33 (emphasis added).

[15] *See also* Specification ¶¶ 0016-17 (noting that numerous specific details are not required to practice the invention; functions can be modified *or removed* and still be within the spirit and scope of the invention) (emphasis added).

[16] Dissent, at 34.

[17] The dissent also notes, somewhat surprisingly, that "[i]f independent claim 1 were to recite the claimed method is 'computer implemented,' I believe it would 'look' more statutory, but that alone may not be sufficient." Dissent, at 33-4. On the contrary, such a recitation would not merely exalt form over substance as the dissent seems to suggest, but would actually

dissent has in effect imported limitations from the specification into the claims. Such a practice, however, has been repeatedly denounced by the Court of Appeals for the Federal Circuit. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005) ("[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments...[C]laims may embrace different subject matter than is illustrated in the specific embodiments in the specification.") (citations and internal quotation marks omitted).

Claim 2 also does not recite statutory subject matter under section 101. Significantly, the claim does not recite any structural limitation to perform the recited method steps, but merely recites that the indicator is an "action-descriptive icon." An "icon" is defined is "[a] sign (as a word or graphic symbol) whose form suggests its meaning."[18] Without more, merely broadly reciting an "icon" -- a symbolic sign -- simply does not cure the deficiencies noted above in connection with claim 1.[19]

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require the steps to be performed on a computer – a machine implementation which would at least minimally satisfy the requirements of § 101. In such a case, the claimed display, menu, and indicator elements would be in the context of a computer implementation which would, at a minimum, provide the requisite transformation of data via a computer.

[18] Merriam-Webster Online Dictionary, *at* http://www.m-w.com (last visited Mar. 25, 2007).

[19] The dissent essentially equates the recitation of an icon with the monitor display screen of claim 5 – a machine implementation that we find statutory. *See* Dissent, at 35; *see also* P. 27 n.22, *infra*, of this opinion. But merely displaying an icon – a mere symbol – hardly requires a machine, let alone a monitor display screen.

Regarding claim 3, the claimed return and help features merely recite desired results intended to be achieved by the method. However, the claim fails to recite any structure, physical step, or machine to perform the claimed method steps.[20] Likewise, claims 6-8 fail to recite any structure, physical step, or machine to perform the claimed method steps.[21]

In short, claims 1-4 and 6-8 are so broad that they are directed to the abstract idea itself, rather than a practical implementation of the concept. In addition, the claims are "so abstract and sweeping" that they would "wholly pre-empt" all applications of the notion of visually representing a future

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[20] Although the dissent states that the return and help features in combination with navigating "seems...to be [a] statutory computer-implemented process," Dissent, at 35, merely allowing a user to navigate hardly requires a machine. Indeed, a user can "navigate" merely by following instructions or a perusing a list of items. See, e.g., P. 27-28, *infra*, of this opinion (citing one example of a implementing the recited steps of claim 1 without a machine). In short, no machine is required to navigate to either a "preference menu" or "dependent help categories" – mere descriptive material that likewise does not require a machine, much less a computer, to implement or display.

[21] The dissent finds the recited recording, notifying, and display prevention steps as computer-implemented process steps. Dissent, at 36. But no machine, let alone a computer, is required to implement these steps. Each of these steps could be implemented without a machine in the context of the example noted on P. 27-28, *infra*, of this opinion (citing one example of a implementing the recited steps of claim 1 without a machine). As we note in that example, the student can select a number of specified options ("future program actions") on a printed form including taking the course for credit which would result in "recording" the future program in the student's academic record. Additionally, notifying the user of the display schedule of the selected future program could be implemented merely by the university indicating course availability. Moreover, preventing the display of a selected future program (e.g., selected course) could be implemented by merely not including the selected course in a printed list.

program action. *See Benson*, 409 U.S. at 68-72, 175 USPQ at 675-677; *see also Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1558 (quoting *Benson*).

We recognize that process claims do not necessarily have to recite the means or structure for performing the claimed steps. *See, e.g., AT&T*, 172 F.3d at 1359, 50 USPQ2d at 1452. But process claims that do not require any machine implementation are intrinsically more abstract than product claims or method claims reciting structure. Consequently, such process claims will often need to recite some sort of transformation act to clearly show that the method claim is for some specific application of the idea and represents something more than just a concept. *See, e.g., id.* at 1358, 50 USPQ2d at 1451 (noting that "AT&T's claimed process" uses "switching and recording mechanisms to create a signal useful for billing purposes.").

Here, claims 1-4 and 6-8 lack the "particularly claimed combination of elements" recited in *Alappat's* claim, the transformation of data by a machine recited in *State Street's* claim, the transformation of electrical signals in *Arrhythmia's* method claim, or the transformation of data useful for billing purposes in *AT&T's* method claim, and therefore lack those characteristics that separate a practical application of an idea from just the idea itself.

State Street's "Useful, Concrete, and Tangible Result" Test Does Not Apply to This Type of Claim Since the Test Is Limited to Machines and Machine-Implemented Methods That Transform Data

As discussed above, the development of the Federal Circuit's data transformation test was in response to a series of cases concerning the eligibility of machines and machine-implemented methods employing a mathematical algorithm. In assessing the eligibility of these specific types

of claims, the court adopted a rule requiring such claims to produce a "useful, concrete, and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1600-1601.

Significantly, however, the cases applying the useful, concrete, and tangible result test have all been confined to machine implementation of mathematical algorithms. Thus, the Federal Circuit has never stated that this is the general test for patent eligibility. In other words, any claim that might arguably yield a "useful, concrete, and tangible result" is not necessarily statutory subject matter.

Specifically, the "useful, concrete, and tangible result" test first appeared in *Alappat*, which states: "This [claimed invention] is not a disembodied mathematical concept which may be characterized as an 'abstract idea,' but rather a *specific machine* to produce a useful, concrete, and tangible result." *Id.*, 33 F.3d at 1544, 31 USPQ2d at 1557 (emphasis added). The court in *Alappat* thus devised a standard to partition patentable inventions using mathematical algorithms from claims for disembodied mathematical concepts.

State Street also involved claims to a machine employing a mathematical algorithm, but in this instance for managing a mutual fund investment portfolio. Finding the claim to be valid under § 101, *State Street* held that "transformation of data ... *by a machine* through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces 'a useful, concrete and tangible result.'" *Id.* at 1373, 47 USPQ2d at 1601 (emphasis added). Likewise, *AT&T* also ties this test to applications of mathematical algorithms: "Because the claimed process applies the

Boolean principle to produce a useful, concrete, and tangible result without pre-empting other uses of the mathematical principle, on its face the claimed process comfortably falls within the scope of § 101." *AT&T*, 172 F.3d at 1358, 50 USPQ2d at 1452; *see also id.* at 1361, 50 USPQ2d at 1453 (concluding that "the focus is understood to be not on whether there is a mathematical algorithm at work, but on whether the algorithm-containing invention, as a whole, produces a tangible, useful result.").

The Federal Circuit, however, has *never* suggested that its "useful, concrete, and tangible result" test was applicable outside the context of data transformation using a mathematical algorithm. Rather, the Federal Circuit has consistently and specifically linked this test to inventions that perform "a series of mathematical calculations" to transform data. Indeed, the Federal Circuit recently noted that the test was specifically devised to handle eligibility issues for claims encompassing mathematical algorithms, thereby suggesting that it is *not* a general test for eligibility. *See NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282, 1324, 75 USPQ2d 1763, 1795 (Fed. Cir. 2005) ("The *requirement* that a process transform data and produce a 'tangible result' was a standard devised to prevent patenting of mathematical abstractions" (citing *AT&T*, 172 F.3d at 1359, 50 USPQ2d at 1452) (emphasis added)). Furthermore, the "useful, concrete, and tangible result" test fails to resolve the tension between *State Street* and *Schrader*.

Indeed, even some members of the U.S. Supreme Court have suggested that, if applied as a general criterion, the "useful, concrete, and tangible result" test would conflict with prior Supreme Court decisions. *Lab. Corp. of Am. Holdings v. Metabolite Labs., Inc.*, 126 S. Ct. 2921, 2928, 79 USPQ2d 1065, 1070 (2006) (Breyer, J., dissent from dismissal as

improvidently granted) (observing that the Federal Circuit's statement that "a process is patentable if it produces a 'useful, concrete, and tangible result' . . . , if taken literally, . . . would cover instances where this Court has held the contrary"). Accordingly, the best reading of the precedent may limit that test to machines and machine-implemented methods using mathematical algorithms to transform data, rather than embracing it as a general test for eligibility.

Accordingly, our understanding of the current precedents is: Any computer program claimed as a machine implementing the program (*Alappat, State Street*) or as a method of a machine implementing the program (*AT&T*), is patentable if it transforms data and achieves a useful, concrete and tangible result (*State Street, AT&T*). Exceptions occur when the invention in actuality pre-empts an abstract idea, as in a mathematical algorithm (*Benson*, 409 U.S. at 71-72, 175 USPQ at 676-677). Because claims 1-4 and 6-8 do not require a machine implementing a mathematical formula to transform data, the "useful, concrete, and tangible result" test is irrelevant to considering the eligibility of these claims.

In essence, claims 1-4 and 6-8 cover ("preempt") every substantial practical application of the recited abstract idea. We conclude that the claim is so broad that it is directed to the "abstract idea" itself, rather than a practical implementation of the concept.

For at least these reasons, claims 1-4 and 6-8 fail to recite statutory subject matter under 35 U.S.C. § 101.[22]

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[22] Our conclusion, however, does not apply to claim 5 which calls for displaying the future program actions menu in a popup window *on a monitor display screen* (emphasis added). This limitation requires performing at

Claims 1-4 and 6-8 Recite Non-Functional Descriptive Material

We also conclude that claims 1-4 and 6-8 merely recite non-functional descriptive material. Significantly, nothing in claims 1-4 and 6-8 precludes displaying and indicating purely textual or symbolic information without a machine. In addition, nothing in the claims precludes the steps to be performed solely by a person. In fact, the scope of claim 1 preempts a wide variety of situations where a user simply selects items from a list and indicates the selected items -- without a machine.

For example, claim 1 covers a conventional situation where a student registers for courses to be offered ("future programs") at a college or university. In this example, a printed list of courses and schedules corresponds to "providing future program information for a plurality of future programs" as claimed.

During registration, the student can select a number of specified options ("future program actions") on a printed form regarding a specific course including, among other things, taking the course for credit ("recording" the future program in the student's academic record), auditing the course, and adding or dropping the course if the student has previously registered for other courses.

The student can then submit this printed course selection to the university (i.e., the university "receiv[es] the selected at least one future program and the selected at least one future program action from the user"). As a reminder, the student can also mark their printed course listing to

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least some method steps on a machine (i.e., a monitor display screen). When considered as a whole, claim 5 at least minimally recites statutory subject matter under § 101.

indicate and "display" their course selections (e.g., by circling, underlining, or highlighting the courses).

This example is merely one of many examples of non-machine implemented methods that are preempted by the scope of claim 1. Not only can all steps be performed solely by a person, the claimed "future program information display," "future program actions menu," and "indicator" can all comprise merely textual or symbolic information (i.e., non-functional descriptive material).

In essence, claims 1-4 and 6-8 merely recite the display of non-functional descriptive material and therefore fail to recite statutory subject matter under 35 U.S.C. § 101. *See Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility* (Interim Guidelines), 1300 Off. Gaz. Pat. Office 142, 151 (Nov. 22, 2005). ("'[F]unctional descriptive material' consists of data structures and computer programs which impart functionality when employed as a computer component. . . . 'Non-functional descriptive material' includes but is not limited to music, literary works and a compilation or mere arrangement of data.").

Rejection of Claims 23-28 Under 35 U.S.C. § 101

Claims 23-28 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. In essence, the claims merely call for a "display" of four images. Significantly, the claim does not require computer or machine implementation. For similar reasons as noted previously in connection with claim 1-4 and 6-8, claims 23-28 merely recite the display (i.e., visual representation) of non-functional descriptive material

("images") and therefore fail to recite statutory subject matter under 35 U.S.C. § 101.

Nothwithstanding the fact that nowhere in claim 23 is a computer recited, the dissent nevertheless finds that there must be an *implicit* computer implementation/process for the user to act with respect to the images. Dissent, at 36 (emphasis added). But no computer implementation is claimed – only a "display." A display need not be a machine, let alone a computer. A display is merely a visual representation of information.[23]

In essence, each of the recited four images merely depicts graphical information that hardly requires the user to "act with respect to the images" at all, let alone define a concrete functional relationship between the images and other aspects of the invention which permit the invention's functionality to be realized. Rather, the images merely constitute non-statutory descriptive material. Without more, reciting mere descriptive material simply fails to define structural and functional relationships between the descriptive material and other claimed aspects of the invention to permit the invention's functionality to be realized. *See Interim Guidelines*, 1300 Off. Gaz. Pat. Office 142, 151 (Nov. 22, 2005).

The dissent's finding of an "implicit" computer implementation in claim 23 effectively engrafts a computerized functionality to the recited limitations where none exists. But "implying" such computer manifestations in claims that simply do not require – let alone recite – such implementations is tantamount to impermissibly importing limitations from the specification into the claims. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1323, 75 USPQ2d 1321, 1334 (Fed. Cir. 2005).

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[23] *See* P. 20, *supra*, of this opinion.

Significantly, we have other independent claims before us on appeal, claims 9 and 17, where there is no question that statutory subject matter is recited. For these claims, certainly no "implication" of a computer implementation is needed to pass muster under § 101.[24]

As a practical matter, we need not – and indeed *must not* – resort to "implying" computer implementations in claim language to transform otherwise nonstatutory subject matter into that which is statutory. As claims 9 and 17 amply demonstrate, the invention on appeal before us is certainly capable of being claimed in a manner that easily meets the threshold of § 101. To this end, the claim drafter is in the best position to ensure that this is done. That is, the claim drafter must ensure that statutory subject matter is *explicitly* recited in the claims and is not left to implications by the Examiner or the Board.

DECISION

We have sustained the Examiner's prior art rejection with respect to all claims on appeal. Moreover, we have entered a new grounds of rejection under new grounds of rejection under 37 C.F.R. § 41.50(b) for claims 1-4, 6-8, and 23-28 as failing to recite statutory subject matter under 35 U.S.C.

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[24] In stark contrast to the mere images recited in claim 23, independent claim 17, for example, recites concrete machine-implemented functionality that amply meets the requirements of § 101. Claim 17 recites, among other things, "an input to receive user input" and a "processor coupled to the input and the display." Also, the processor is configured to implement the five recited functions. This clear machine implementation easily meets the threshold of statutory subject matter under § 101 -- a point indeed not in dispute. But such a concrete recitation is a far cry from the mere images recited in claim 23.

§ 101.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (amended effective Sept. 13, 2004, by final rule notice 69 Fed. Reg. 49,960 (Aug. 12, 2004), 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)). 37 C.F.R. § 41.50(b) provides that "[a] new ground of rejection . . . shall not be considered final for judicial review."

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED
37 C.F.R. § 41.50(b)

JOSPEH L. DIXON, *Administrative Patent Judge*

I concur-in-part and dissent-in-part.

35 U.S.C. § 102

I concur in the affirmance of the rejection under 35 U.S.C. § 102.

35 U.S.C. § 101

I cannot join the majority in finding that the instant claims which the majority has rejected are directed to non-statutory subject matter under 35 U.S.C. § 101.

The majority goes through extensive evaluation of the case law and controlling precedents. I agree with the majority's general analysis, yet I find that the merits of rejection when applied to the extensive case law discussions is quite brief and silent as to the appropriate claim interpretation with which to evaluate the instant claimed invention.

While the majority's examples are creative in their claim interpretation to find the instant claims non-statutory, it is the claim limitations, when interpreted in light of the Specification and giving the claims their ordinary and customary definitions in the relevant/pertinent art, that define the claimed invention.

Here, I find the Specification to be solely directed to a computer implemented invention for a future program action indication display process. The majority has not identified where or how Appellants' Specification permits such a broad and sweeping interpretation when there is no hint of a non-computer implemented method envisioned therein. Nor has

the majority identified how these terms of art in the Graphical User Interface (GUI) art are to be interpreted out of this particular context. If independent claim 1 were to recite the claimed method is "computer implemented," I believe it would "look" more statutory, but that alone may not be sufficient. Even without that extra modifier of "computer-implemented," I find that the recited steps of the method when read in light of Appellants' Specification, as they are required to be interpreted rather than in a vacuum, are directed to a statutory process where data is transformed by a machine. Here, a user selects a future program and then is provided a future program action menu to select a future program action, and the user accepts or modifies the future program action and then displays with an indicator the selected future program and selected future program action.

Independent claim 1 recites:

> A method for indicating future program action on a future program information display comprising:
>
> providing future program information for a plurality of future programs, at least one future program being selected by a user;
>
> providing, on a future program action menu, a plurality of future program actions for the selected future program, at least one future program action being selected by the user, each future program action being an action selected to be performed on a future program;
>
> allowing the user to accept or modify the action;
>
> receiving the selected at least one future program and the selected at least one future program action from the user; and
>
> displaying the future program information of the selected at least one future program with an indicator such that the indicator indicates the selected at least one future program action.

Here, I find these specific steps with actions being performed with a user with respect to at least a future program, a future program action, and an indicator to be sufficient to set forth a statutory process which is

interacting with a computer implemented process and display with an indicator to the user. I find these limitations to be sufficient to qualify as statutory subject matter rather than a mere abstract and disembodied idea as maintained by the majority.

I find the majority's rejection to be overly general and does not address all of the specific inter-related limitations in their rejection and is silent with respect to how this is a reasonable interpretation in light of the disclosed invention. From my review of the disclosed invention, I do not find any language which hedges the computer implementation or implies that Appellants intend to claim more than the disclosed computer implemented system and method. Therefore, I cannot agree with the majority's claim interpretation to manufacture a non-statutory invention with the non-computer interpretations of the computer limitations from one that is disclosed and claimed as statutory subject matter. Therefore, I find that the majority has taken an unreasonable interpretation of the instant claim limitations and recited actions, when read in light of the Specification for context.

I do not find any over generalized descriptions in this Specification with which to stretch the limits of reasonable claim interpretation. While the decision has good analysis of the case law, there is not enough citation to the Specification or to the relevant prior art definitions in the application of the case law to the claim language.

Additionally, I find that the recitation of an "icon" in claim 2 seems to be similar to monitor in claim 5 which was found to be statutory subject matter. This is clearly not a college registration process done in paper. Additionally, the "help feature" and "return feature" in combination with

"navigating" in claim 3 also seems to me to be statutory computer-implemented process.

Claim 3 recites:

> 3. The method of claim 1, wherein the future program actions menu comprises features selected from the group consisting of a return feature, allowing user to navigate back to preference menu, and a help feature, allowing user to navigate to several dependent help categories, the features being able to be selected by a user.

This to me is a computer implemented process.

Claim 6 recites :

> 6. The method of claim 1, wherein the selected at least one future program action includes actions selected from the group consisting of recording the selected at least one future program, notifying the user of the display schedule of the selected at least one future program, and preventing the display of the selected at least one future program.

In dependent claim 6, I find the actions of recording, notifying and preventing the display are more than a mere abstractions, but computer-implemented process steps.

With respect to independent claim 23, I find the actions of the user to be more than merely non-functional descriptive material so as to be essentially printed matter without structure or implementation. For the user to act with respect to the images, I find that there must be an implicit computer implementation/process. For the above reasons, I cannot agree with the majority's rejection.

CONCUR-IN-PART AND DISSENT-IN-PART

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